In the United States Patent and Trademark Office

In re the Application of:

Leigh Allen Williamson	)	
Serial Number: 09/902,694	)	Group: 2157
Docket Number: AUS920010324US1	)	Examiner: Gregory G. Todd
Filed on: 07/12/2001	)	
For: "Pluggable URL Providers in a	)	
J2EE Server"	)	

REPLY BRIEF

(First Appeal Reinstatement)

Revised Appeal Brief

In reviewing the Examiner's Answer dated 02/07/2008, and our Appeal Brief dated 11/19/2007, we have noticed some typographical errors in our Appeal Brief. Most notable of which is a repetition of a citation from the Austin reference on page 8 of the Brief.

We apologize for any confusion this may cause.

Examiner's Responses to Arguments in Our Appeal Brief

In Item 10 of the Examiner's Answer, there are several statements which we believe are incorrect and wish to take issue. We maintain all previous arguments set forth in all replies to the Examiner, and set forth in both previous Appeal Briefs.

(1) The Examiner stated on pg. 9 lines 3 - 6:

> "Appellant argues a prima facie case of obviousness has not been
> established as Austin teaches away from the proposed combination
> vis-a-vis server-based implementation of the invention. Appellant
> does not argue, and thus agrees, that the system of Austin performs
> the remaining functionality of the claims."

We respectfully disagree. Appellant does not necessarily agree that all technical aspects of our claims are taught by Austin. Such a statement by the Examiner on behalf of the Appellant

is improper. Appellant's burden to point out technical differences between the cited art and the claims is incurred only *after* the Examiner has established a *prima facie* case of obviousness. The initial burden in the first instance, however, lies with the Examiner to establish a *prima facie* case of obviousness. "If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent". *In re* Oetiker, 977 F.2d 1443, 24 USPQ2d 1444 (Fed. Cir. 1992).

We believe the "without more . . . " phrase in the *In re* Oeticker decision clearly establishes that the Appellant is not required to rebut the technical opinions or conclusions of the Examiner regarding the cited references if a *prima facie* case of obviousness has not been established for other reasons.

In order to establish a *prima facie* case of obviousness, the Examiner not only must show where each claim element, step, and limitation is taught in the reference(s), but the Examiner must also show where *suggestion and motivation* are found in the cited art. A *prima facie* case of obviousness requires that the reference teachings "appear to have suggested the claimed subject matter". *In re* Rhinehart, 531 F.2d 1048, 189 USPQ 143, 147 (C.C.P.A. 1976)

So, we believe that at this point in the examination, and in view of the statements in the Austin disclosure regarding non-server-based embodiments teaching away from server-based embodiments, that the initial burden of establishing a *prima facie* case of obviousness has not been met by the Examiner because motivation does not exist.

"Nothing more" (*In re* Oetiker) is required of Appellants' reply other than to establish that the Examiner's burden has not yet been met. This does not imply that the we agree with any other aspect of the Examiner's argument. The Examiner must meet this burden first.

(2) The Examiner stated on page 9, lines 6 - 10 (our emphasis added):

> *As such, while Austin is primarily concerned with running the system on a user agent or client (see Abstract), Austin is not limited to the standard 'client' that one thinks of in a client-server structure, rather Austin's user agent/client is a web browser, such web browser could be used on a client or server.*

It is unsupported by the Examiner how Austin's client is not limited to the "standard" client, but that Austin's "agent/client" is a web browser and thus could be used on a server.

This defies the definitions of client and server – if a client is used directly on a server, doesn't it then become a server? If not, what differentiates a client from a server in the art? We respectfully submit that the Examiner's interchangeable agent/client and server definitions are not supported by the cited art, nor are they supported by any extrinsic source such as a dictionary.

We also respectfully submit that the Examiner's characterization that ". . . Austin is _primarily concerned_ with running the system on a user agent or client . . . " is inaccurate and not supported by Austin's disclosure. In view of Austin's statements about running their functions on a client _"without interacting with an HTTP server at any point", "without connecting to a web server",_ and _"without utilizing standard web server protocol"_, to characterize Austin's running on a client as merely a "primary concern" extremely understates Austin's teaching away from running on or with a server. To this end, we believe that the Examiner is improperly using hindsight to view the Austin disclosure through the lens of our disclosure, reinterpreting Austin's disclosure to figure out a way to realize our server-based advantages.

(3) The Examiner has also agreed that ". . . Austin does not explicitly teach the use of an _application_ server . . ." (Pg. 11, line 1), but that Bowman provides evidence of using an application server with a client. However, it has been clearly established by the Court, as cited in our Appeals Brief, teaching away by one reference cannot be overcome by statements in other references for the purposes of rejections under 35 U.S.C. §103(a). We do not believe this is a "preponderance of the evidence" type of analysis where it is to be determined if _most_ of the references teach towards a combination or modification. Instead, the Court has established that _only one_ reference must teach away from the combination or modification to render the proposed combination non-obvious. _In re_ Rudko [Civ. App. No. 98-1505) (Fed. Cir. May 14, 1999).

Conclusion

We believe that the Examiner's Answer provides further evidence of erroneous examination. An invention is not obvious where the Examiner fails to provide suggestion to make a combination or modification, even if the references _could have_ been combined or modified. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability

of the modification." *In re* Fritch, 972 F.2d 1260, 23 USPQ2d 1783-84 (Fed. Cir. 1992) (quoting *In re* Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

And, an invention is not obvious where one prior art reference teaches away from the combination or modification as proposed by the Examiner. *In re* Rudko, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999) (unpublished).

Austin has clearly stated a preference for client-side implementations away from server-side functionality, and we have claimed server-side functions, steps, and elements.   Motivation to combine requires more than just a trade-off, but also desirability.   Winner Int'l Royalty Corp. V. Wang, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir.), *cert. denied,* 530 U.S. 1238 (2000).

The Examiner has supported his opinion with statements of generalized advantages of the proposed modifications and combination, but these types of statements are insufficient to show motivation. "Given the subtle but powerful attraction of a hindsight-based obviousness analysis, we require a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re* Beasley, Civ. App. 04-1225, slip op. at 6-7, 2004 WL 2793170 (Fed. Cir. Dec. 7, 2004) (unpublished)

For these reasons, we believe the rejections of our claims are erroneous, and we request allowance of our claims by the Board of Patent Appeals and Interferences.

Respectfully,

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